



FILE NO. 033956/US3 – 475494.00005

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

**On Appeal to the Board of
Appeals and Interferences**

Appellant(s) : Wayne COHEN
Serial No. : 10/796,446
Filed : March 9, 2004
For : BOTTLE OPENER

Examiner: James G. Smith
Art Unit: 3723

BRIEF ON APPEAL

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Gary Abelev

Attorney Name

40,479

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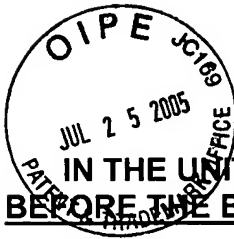
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RULE(S)

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BRIEF ON APPEAL

On November 1, 2004, the U.S. Patent and Trademark Office (the "Patent Office") received a Notice of Appeal from the final rejection of claims 26 and 27 contained in the Final Office Action issued by the U.S. Patent and Trademark Office (the "Patent Office") on July 28, 2004 in the above-identified patent application.

In accordance with 37 C.F.R. § 1.192(a), this brief is submitted in triplicate in support of the appeal of the final rejection of pending claims 26 and 27. For at least the reasons set forth below, the final rejection of pending claims 26 and 27 should be reversed.

I. REAL PARTY IN INTEREST

The real party in interest of the present application is the inventor, Wayne Cohen.

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II. RELATED APPEALS AND INTERFERENCES

Appellant and the Appellant's legal representatives are unaware of any appeals or interferences related to the present application which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 26 and 27 stand finally rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over "any of Cohen Patents of record"¹ (and thus shall be referred to herein below as the "Cohen Patent"), in view of U.S. Patent No. 4,560,344 issued to Kietabl (the "Kietabl Patent") or U.S. Patent No. 5,169,305 issued to Kee (the "Kee Patent").

Appellant appeals from the final rejections of pending claims 26 and 27. A copy of all of the pending claims is attached hereto in the Appendix.

IV. STATUS OF AMENDMENTS

Subsequent to the issuance of the Final Office Action dated July 28, 2004, along with this Appeal Brief, an Amendment is being filed which amends the Substitute Specification of this application to clarify the language for claiming priority to a parent U.S. Patent Application Serial No. 09/865,349.

¹ Only one of the "Cohen patents" can be arguably relied on to reject Independent claims 26 and 27 under 35 U.S.C. § 103(a). This is because the "Cohen patents" and the above-referenced application have the same inventor listed thereon. Accordingly, only 35 U.S.C. §102(b) reference of the "Cohen patents" that lists the same inventor as the present application can be relied on for rejecting independent claims 26 and 27 under 35 U.S.C. § 103(a), and the present application claims priority from U.S. Patent Application Serial No. 09/865,349, filed on May 25, 2001. The only such reference of the "Cohen patents" that may be relied by the Examiner, if at all, is **U.S. Patent No. 6,056,464** to Cohen (the "Cohen Patent").

V. SUMMARY OF INVENTION

Generally, the invention described in the above-identified application is directed to a bottle opener and a maraca 10. (See Appellant's Specification, e.g., p. 2, paras. [0004] and [0005]). The maraca 10 includes a shell 12 which encloses pellets 14 for providing a rattle-type sound. The maraca 10 includes a handle 16 which is generally cylindrical, and has a tapered shape including a wide portion for gripping by the hand of a user. The wide portion of cylindrical handle 16 is provided with a transverse groove 18 formed therein. The groove 18 includes a bottom grooved surface 24, a first side surface 26 and a second side surface 22. A metal tool 20 is mounted within groove 18, and arranged to engage the edge of a bottle cap for opening a bottle. (See *id.*, pp. 4-5, para. [0019]).

The metal tool 20 is mounted within the groove 18 of the cylindrical handle 16. The metal tool 20 includes a first web portion 32, a second web portion 34, a third web portion 36, and a fourth web portion 38. The fourth web portion 38 of the metal tool 20 is driven into a slot 44 formed in the cylindrical handle 16. The slot 44 is substantially perpendicular to the central axis 28. The fourth web portion 38 of the metal tool 20 is inserted into the slot 44 until the first web portion 32 comes in contact with an under cut 24A of the surface 24. The undercut 24A is formed in surface 24 to accommodate the cooperation with the metal tool 20. A portion 40 of the fourth web portion 38 may be pressed out to form a tooth for engaging the interior of slot 44, and to retain the metal tool 20 therein. (See *id.*, p. 5, para. [0022]).

VI. ISSUE(S) ON APPEAL

The issues on appeal are as follows:

A. Whether the Examiner incorrectly refused to acknowledge a claim of priority to a parent U.S. Patent Application Serial No. 09/865,349 (the "Parent Application") which has the same inventor and owner as the instant application, and thus failed to remove U.S. Patent Nos. D428,298; D4289942; and D437,885 from being applied as prior art references to the claims of the present application; and

Whether the Examiner failed to establish a *prima facie* case that claims 26 and 27, which stand rejected under 35 U.S.C. § 103(a), are unpatentable over the Cohen Patent in view of the Kietaihl Patent or the Kee Patent.

VII. GROUPING OF CLAIMS

Issue A

Group I - all pending claims 26 and 27.

Issue B

Group I - all pending claims 26 and 27.

VIII. ARGUMENTS

1. Prior Art relied on by the Examiner

The Examiner relies on the Cohen, Kietaihl and Kee Patents for maintaining the final rejections (as well as other U.S. patents issued to the inventor pf

the present application which are believed to be inapplicable prior art references – as provided below).

The Cohen Patent relates to a novelty attachment 10 for a pen or pencil 12, which is formed as a hollow shell 14 with sounding beads therein. The attachment is provided in the form of a maraca without a handle, and when attached to a pen or pencil may be shaken to produce a maraca rattle sound. (See Cohen Patent, Abstract; and col. 1, Ins. 59-62).

The Kietabl Patent relates to a combination cigarette lighter and bottle opener which includes an elongated body, a cigarette lighter assembly, a hollow sleeve and a bottle opener. (See Kietabl Patent, col. 1, Ins. 31-34). The opener 27 is disposed adjacent to an end face 37 of a fuel tank 12, and the lighter assembly 14 is disposed at an opposite end face 38. Parallel side walls 41, 42 of a hollow sleeve 22 terminate at an inner end 25, with the side wall 41 terminating at a fulcrum portion 34, and the side wall 42 terminating at a lever position 29. (See *id.*, col. 3, Ins. 9-14). The bottle opener 27 also includes a separate v-shaped metal insert lever 46 which has a first end portion 48 and a second end portion 47. The second end portion 47 has an outer end 49 for engaging the rim of a bottle cap 31, extends slightly beyond an opening, and lies adjacent to an interior wall 29a between ribs 51a and 52a that serve to position the sides of the end portion 47. (See *id.*, col. 3, Ins. 33-36, 41-43, and 48-51). An outer face of the fuel tank 12 (which is opposite to the end face 37) and the interior wall 29a are substantially planar, and provided adjacent to one another. In addition, a section of the lever 46 extending toward a rim engaging outer end 49 extends at an angle from the

direction of extension of the outer face of the fuel tank 12, and substantially along the interior wall 29. (See *id.*, Fig. 1).

The Kee Patent relates a gas-lighter with an opener which is also fit to remove tabs of tin cans, and includes a perfume chamber to emit a fragrance. (See Kee Patent, col. 1, Ins. 24-30). As provided in the Kee Patent, the opener includes an opener section 3 which has a shape that is similar to the shape of an opener piece 4, as well as a screw groove 10. The screw groove 10, with a screw driven therein, is used for fixing the opener piece 4 to the opener section 3. (See *id.*, column 2, Ins. 25-29). The opener piece 4 has a catch 4a which, in operation, catches beneath the underside edge of a bottle cap. (See *id.*, col. 2, Ins. 30-33).

2. Relevant Statutory Law, Case Law and Procedure(s)

Claim of Priority under 35 U.S.C. § 120

35 U.S.C. § 120 clearly states that “[a]n application for patent ..., which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director.”

37 C.F.R. §1.78(a)(2)(i) further provides that “any nonprovisional application ... claiming the benefit of one or more prior-filed copending nonprovisional applications ... must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) application number ... and indicating the relationship of the applications.”

Non-Obviousness in view of 35 U.S.C. §103(a)

“To reject claims in an application under Section 103, an examiner must show an unrebutted *prima facie* case of obviousness.” *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998). The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated:

Under Section 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

Indeed, to sustain a rejection under 35 U.S.C. § 103(a), there must be some teaching, other than the instant application, to alter the prior art to arrive at the claimed invention. “The problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem.” *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 679 (Fed. Cir. 1998).

Thus, to establish a *prima facie* case of obviousness, the Examiner has an obligation to construe the scope of the prior art, identify the differences between the claims and the prior art, and determine the level of skill in the pertinent art at the time of the invention. From this, the Examiner must provide a positive reason why it would be

obvious to modify the prior art to arrive at the claimed invention. Absent an explanation of “the specific understanding or principle within the knowledge of a skilled artisan that would motivate one with no knowledge of [applicant’s] invention to make the combination, [there is an inference] that the examiner selected these references with the assistance of hindsight,” which is clearly impermissible. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). A positive suggestion or motivation to alter the prior art is a requisite safeguard against hindsight being used to negate patentability. *Id.* at 1459.

“Multiple cited prior art references *must suggest the desirability* of being combined and the reference must be viewed without the benefit of *hindsight* afforded to the disclosure. *In re Paulsen*, 30 F.3d 1475, 1482 (Fed. Cir. 1994); *emphasis added*. “It is improper to use the inventor’s disclosure as a road map for selecting and combining prior art disclosures.” See *Grain Processing Corp. v. American Maize-Products Corp.*, 840 F.2d 902, 907 (Fed. Cir. 1988). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not be based on Appellant’s disclosure. See *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

When combining references for purposes of demonstrating obviousness of the claimed invention, the first requirement is that a suggestion, teaching, or motivation to combine the prior art references be shown. *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing is an “essential evidentiary component of an obviousness holding.” *Id.*, emphasis added. This evidence may flow from the (1) prior art references themselves, (2) the knowledge of

one of ordinary skill in the art, or, in some cases, (3) from the nature of the problem to be solved. *Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.*, 229 F.3d 1120, 1125 (Fed. Cir. 2000), *citing Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed.Cir. 1996). However, the suggestion more often comes from the teachings of the pertinent references. *See In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). "This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." *Brown & Williamson Tobacco Corp.* emphasis added.

3. Issue on Appeal

Group I – Claims 26 and 27

In the Final Office Action, the Examiner alleges that "one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120", i.e., from the filing date of the Parent Application (which was filed on May 25, 2001) are absent from the application, and for this reason refused to remove U.S. Patent Nos. D428,298; D429,942; and D437,885 from being applied as prior art references to the claims of the present application. Appellant respectfully disagrees, and asserts that each and every requirement necessary for obtaining the claim of priority to the Parent Application has been complied with by Appellant, even though minor typographical inconsistencies were present in the application which do not effect the claim of priority to the Parent Application.

The present application was filed on March 9, 2004 during the pendency of the Parent Application which has the same inventor and owner as the above-identified application). When the present application was filed, a Preliminary Amendment and Substitute Specification were submitted therewith. In the Preliminary Amendment, Appellant requested the entry of the Substitute Specification, which included an entire paragraph specifically addressing the claim of priority to the Parent Application under 35 U.S.C. §120. In particular, pursuant to the requirements of 35 U.S.C. §120 and 37 C.F.R. §1.78, the Substitute Specification previously provides following language:

“CROSS-REFERENCE TO RELATED APPLICATIONS

[0001] This application is a national stage application of U.S. Patent Application No. 09/865,349, which was filed on May 25, 2001 (the “349 Application”), which is a continuation application of the U.S. Patent Provisional Application Serial No. 60/289,938, which was filed on May 9, 2001 (the “938 Application”), the entire disclosures of which are incorporated herein by reference. The application claims priority from the ‘349 Application pursuant to 35 U.S.C. § 120.”

In the Office Action, the Examiner notes a minor typographical issue associated with this statement, and states that the present application is not a “national stage” application, but likely a “CON” application from the Parent Application. For this reason, the Examiner apparently refused to grant the priority of the present application to the filing date of the Parent Application, and should be acknowledged.

Appellant respectfully asserts that because the Parent Application and its filing date was clearly identified in the above-provided paragraph, and a claim of priority

was explicitly included therein (pursuant to 35 U.S.C. § 120), the claim of priority of the present application to the Parent Application was appropriately made.

While Appellant believes that the minor typographical inconsistency referred to by the Examiner cannot render the claim of priority to the Parent Application ineffective, Appellant agrees that the present application is a continuation application (or “CON”) of the Parent Application. Accordingly, in order to expedite the resolution of this issue, Appellant respectfully presents, along with this Appeal Brief, an Amendment which modifies the above-described section in the specification, as follows:

“CROSS-REFERENCE TO RELATED APPLICATIONS

[0001] This application is a continuation ~~national-stage~~ application of U.S. Patent Application No. 09/865,349, which was filed on May 25, 2001 (the “349 Application”) issued as U.S. Patent No. 6,775,869 on August 17, 2004, ~~which is a continuation application of the~~ claims priority to U.S. Patent Provisional Application Serial No. 60/289,938, which was filed on May 9, 2001 (the “938 Application”), the entire disclosures of which are incorporated herein by reference. The application claims priority from the ‘349 Application pursuant to 35 U.S.C. § 120.”

Accordingly, for at least the reasons presented herein above, Appellant respectfully requests the Board to confirm that the present application is a continuation application of the Parent Application, and appropriately claims priority therefrom. Therefore, Appellant respectfully requests the Board to remove U.S. Patent Nos. D428,298; D429,942; and D437,885 (all issued to the inventor and owner of the present application) from being applicable to the claims of the present application under 35 U.S.C. §§ 102 and 103.

Group II – Claims 26 and 27

Appellant respectfully asserts that there is absolutely no teaching, suggestion, motivation or incentive to combine the Cohen Patent with the Kietabl Patent or the Kee Patent to teach or suggest Appellant's invention, as recited in independent claim 26, and claim 27 which depends from this independent claim 26, for the following reasons.

Independent claim 26 relates to a maraca which comprises, *inter alia*,

a maraca body;

a maraca handle connected to the maraca body; and

a bottle cap opener connected to the maraca handle.

In the Final Office Action, the Examiner admits that the Cohen Patent does not show "the use of a bottle cap opener of the combination tool." (See Office Action dated January 17, 2003, p. 2, last four lines). However, the Examiner alleges that "[i]t would therefore be obvious to one skilled in the art at the time the invention was made to modify any of the Cohen by using a bottle cap opener instead of second tools or devices because either Kietabl or Kee suggest the use of such a bottle opener in combination type tools." (See *id.*, p. 2, last line to p. 3, lines 2-5). As provided herein above, Appellant shall only address the Cohen Patent herein since U.S. Patent Nos. D428,298; D429,942; and D437,885 are not appropriate prior art references for the claims pending in the present application for at least the reasons present herein above.

Contrary to the Examiner's belief, Appellant respectfully submits that **there is no teaching, suggestion, incentive or motivation to combine** the teachings of the

Kietaibl Patent or the Kee Patent with those of the Cohen Patent (or even the other Cohen Patents which should not be applicable as prior art references to the claim) to teach or suggest the assembly of a bottle cap opener connected to a maraca handle, which is connected to a maraca body, as explicitly recited in independent claim 72. The Examiner is respectfully reminded that "[m]ultiple cited prior art references must suggest the desirability of being combined and the reference must be viewed without the benefit of hindsight afforded to the disclosure." (emphasis added) *In re Paulsen*, 30 F.3d 1475, 1482 (Fed. Cir. 1994), emphasis added. "The problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem. *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 679 (Fed. Cir. 1998). Appellant respectfully submit that *there is no motivation or incentive to combine* the Kietaibl Patent or the Kee Patent with the Cohen Patent to allegedly form Appellant's claimed invention.

In particular, one of the objects of the present invention is to "provide a bottle opener which may, for example, be incorporated into the handle of another item, such as a maraca." (See Appellant's Substitute Specification, e.g., page 2, paragraph [0003], as amended). However, the Cohen Patent is to provide "a new novelty attachment for a pencil or pen that include a hollow shell with sounding beads which, when attached to a pen or pencil can act as a maraca or rattle." (See Cohen Patent, column 1, lines 6-9). Thus, the problem confronted by the inventor for the above-identified application is completely different than the problem confronted by the inventor in the Cohen Patent (i.e., the same inventor). Indeed, the Cohen Patent nowhere mentions that the pen or pencil can include any type of an opener, much less a bottle

cap opener as recited in independent claim 72. Therefore, there is no teaching, suggestion, motivation or incentive to combine the Cohen Patent with the Kietabl Patent or the Kee Patent to teach or suggest Appellant's claimed invention as recited in independent claims 72.

Appellant further submits that "[i]t is improper to use the inventor's disclosure as a road map for selecting and combining prior art disclosures." See *Grain Processing Corp. v. American Maize-Products Corp.*, 840 F.2d 902, 907 (Fed. Cir. 1988). "[T]he reference must be viewed without the benefit of hindsight afforded to the disclosure." *In re Paulsen, supra*. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art and not be based on Appellant's disclosure. See *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Appellant respectfully submits that the Examiner is relying on an **improper hindsight reconstruction**, which cannot be used for rejecting the claims of the above-identified application.

Accordingly, Appellant respectfully asserts that there is no teaching, suggestion, motivation or incentive to combine the Cohen Patent with the Kietabl Patent or the Kee Patent to teach or suggest Appellant's invention as recited in independent claim 26, in the manner contemplated by the Examiner. Because claim 27 depends from claim 26, respectively, it is respectfully asserted that this dependent claim is allowable for at least the same reasons.

Accordingly, without the ability to combine the Cohen Patent with the Kietabl Patent or the Kee Patent, the resultant combination (if any) fails to teach or suggest the subject matter recited in claims 26 and 27. Therefore, Appellant

respectfully requests the Board to reverse the Examiner's § 103(a) rejection of claims 26 and 27.

IX. CONCLUSION

For at least the reasons indicated above, Appellant respectfully submits that the invention recited in the presently rejected claims of the present application, as discussed above, is new, non-obvious and useful. Reversal of the Examiner's rejections of the claims is therefore respectfully requested.

Respectfully submitted,

Dated: July 20, 2005

By. 

Gary Abelev
Patent Office Reg. No. 40,479

Attorneys for Appellant(s)
DORSEY & WHITNEY L.L.P.
250 Park Avenue
New York, New York 10177
Telephone: (212) 415-9371

APPENDIX

Claims as currently pending:

26. A maraca comprising:

a maraca body;

a maraca handle connected to the maraca body; and

a bottle cap opener connected to the maraca handle.

27. The maraca of claim 26, wherein the bottle cap opener is incorporated into the maraca handle.

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